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OFFICE OF PETITIONS

In re Application of
Ryuji Ueno et al
Application No. 09/816,655
Filed: March 26, 2001
Attorney Docket No. Q58513

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: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(6)
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This is a decision on the petition under 37 CFR 1.78(a)(6), filed August 2, 2001, to accept an unintentionally delayed claim under 35 USC 119(e) for the benefit of a prior filed provisional application.

The petition is **dismissed** as moot for the reasons stated below.

The petition under 37 CFR 1.78(a)(6) to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior filed provisional application must be accompanied by: (1) the surcharge of \$1,240 set forth in 37 CFR 1.17(t); (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5) and the date the claim was filed was unintentional; and (3) include a reference to each prior provisional application in an application data sheet (§ 1.76) or be contained in the specification or amended to contain such reference in the first sentence following the title. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on March 26, 2001, within twelve months of the filing date of the prior provisional application, Application No. 60/191,755, which was filed on March 24, 2000 (March 24, 2001 is a Saturday), for which priority is claimed. The petition was submitted during the pendency of the nonprovisional application seeking the benefit of the prior provisional application. A reference to the prior provisional application has been included in the transmittal for the application, but was not included at the time of filing in an oath or declaration or in the first sentence of the specification following the title.

The current procedure where a claim for priority under 37 CFR 1.78(a)(5) is not included the first sentence of the specification or on an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. However, on the other hand, if the PTO does not note the claim for priority to the provisional application in the oath or declaration or transmittal letter

submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR 1.78(a)(6). In the instant case, the Office noted the claim for priority of the provisional application in the transmittal letter, as indicated by Office computer database records.

Petitioner states that the filing of the sworn English translation of U.S. Provisional Application No. 60/191,755 in the nonprovisional application was inadvertently not docketed after the rule change and that the deadline for filing the sworn translation was not discovered until after the period set forth under 37 CFR 1.78(a)(5). Therefore, petitioner requests acceptance of an unintentionally delayed claim under 35 USC 119(e) for the benefit of a prior filed provisional application.

Provisional Application No. 60/191,755 was filed on March 24, 2000 in the Japanese language. In view thereof, a Notice to File Missing Parts of Provisional Application was mailed on May 18, 2000, requiring the submission of an English translation and a \$130 surcharge fee. In response, a verified English language translation and a \$130 surcharge fee were received on July 18, 2000.

Since the verified English language translation was filed in the provisional application within the required period set forth in 37 CFR 1.78(a)(5), the instant petition under 37 CFR 1.78(a)(6) is unnecessary and is dismissed as involving a moot issue.

In view of the above, the \$1,240 petition fee submitted is unnecessary and will be credited to Deposit Account No. 19-4880.

Any inquiries concerning this decision may be directed to the undersigned at 305-8680.

This application is being forwarded to the Office of Initial Patent Examination Division for preexamination processing. Afterwards, the application will be forwarded to Technology Center Art Unit 1614 for processing the amendment filed September 6, 2001, and for consideration by the examiner of the claim under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5) for the benefit of the prior provisional application, Application No. 60/191,755, filed on March 24, 2000.


Frances Hicks

Petitions Examiner
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